UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014

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ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2005*.

2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

　　4a) Of the above claim(s) *13,15 and 24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-12,14,16-23 and 25-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is response to Applicants' response filed on 08/09/2005.

2.   Claims 13 and 24 have been cancelled.

3.   Claim 15 was cancelled dated 02/11/2004.

4.   Claims 1-12, 14, 16-23 and 25-27 are pending in this application.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of
the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of
the various claims was commonly owned at the time any inventions covered therein
were made absent any evidence to the contrary. Applicant is advised of the obligation
under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was
not commonly owned at the time a later invention was made in order for the examiner to
consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)
prior art under 35 U.S.C. 103(a).

7.   Claims 1-5, 7-12, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter

Graham) in view of Patent No.: US 5,664,207 issued to Crumpler et al. (hereinafter

Crumpler).

With respect to claim 1, Graham teaches a method in a data processing system

for sharing text in an electronic book (displaying/selecting stored electronic document

containing a plurality of pages with visual indications of the locations such as

highlighting the text" figs. 2s', 3, 4 and 9's, col. 3, lines 18-67);

receiving a user input selecting the text from the electronic book to form selected

text (using the mouse as input device for receiving the text from electronic document or

e-book to form a selected text by highlighted the selected text after the e-book is

displayed (fig. 1, item 36 or 30, fig. 2's item 220 and 224, col. 3, lines 56-67 and col. 4,

lines 1-8); and

automatically sending the selected to each electronic document (fig. 8, the

selected is automatically send to another user on the system: abstract, col. 6, lines 60-

67 and col. 7, lines 1-5).

Graham teaches a method for highlighted or annotated text of stored electronic

document or e-book, which contains plurality of pages including table of contents,

receiving a user input via input device such as mouse or keyboard and highlighting the

selected text after the e-book is displayed. Graham does not clearly teach a designated

set of recipients in response to receiving the user input selecting the text.

However, Crumpler teaches automatically selecting for a designated set of
recipients in response to receiving the user input selecting the text (fig. 6A, items 606
and 608, col. 3, lines 28-62 and col. 4, lines 38-56; also see col. 9, lines 32-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at
the time the invention was made to combine the teachings of Graham with the
teachings of Crumpler. One having ordinary skill in the art would have found it motivated
to utilize the use of a designated set of recipients in response to receiving the user input
selecting the text as disclosed (Crumpler's col. 3, lines 45-62 and col. 4, lines 38-56),
into the system of Graham for the purpose of automatically distributed the information to
all the user in the communication network, thereby, automatic sharing of information is
provided more efficient (Crumpler's col. 4, lines 38-56).

With respect to claim 2, Graham teaches a method in a data processing system
as discussed in claim 1.

Graham teaches a method for highlighted or annotated text of stored electronic
document or e-book, which contains plurality of pages including table of contents,
receiving a user input via input device such as mouse or keyboard and highlighting the
selected text after the e-book is displayed. Graham does not clearly teach displaying a
list wherein the designated set of recipients is selected from the list.

However, Crumpler teaches set of recipients in the recipient's in-box and is
displayed upon selection (col. 3, lines 28-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at
the time the invention was made to combine the teachings of Graham with the

teachings of Crumpler. One having ordinary skill in the art would have found it motivated

to utilize the use of a designated set of recipients in response to receiving the user input

selecting the text as disclosed (Crumpler's col. 3, lines 45-62 and col. 4, lines 38-56),

into the system of Graham for the purpose of automatically distributed the information to

all the user in the communication network, thereby, automatic sharing of information is

provided more efficient (Crumpler's col. 4, lines 38-56).

With respect to claim 3, Graham teaches wherein the selected is highlighted text

(col. 3, lines 56-65).

With respect to claim 4, Graham teaches wherein the highlighted text in a

different color from unselected, bolded text, and text with a different font type from

unselected text (col. 3, lines 56-67).

With respect to claim 5, Graham teaches storing the highlighted text in a data

structure (in the user profile data structure: col. 5, lines 13-16).

HTML data structure: sections 0077 & 0186).

With respect to claim 7, Graham teaches wherein the text is a notated message

of text in the electronic book (figs. 2s' and 9s').

With respect to claim 8, Graham teaches wherein the text is a highlighted

passage of text in the electronic book (highlighting the text: col. 3, lines 56-67).

With respect to claim 9, Graham teaches wherein the sending step sends the

highlighted text to the designated set of recipients using a communications link (figs 5

and 6A).

With respect to claim 10, Graham teaches wherein the sending step sends the selected text to the designated set of recipients in an electronic mail message (document in electronic form, fig. 5 and col. 4, lines 45-56).

With respect to claim 11, Graham teaches wherein the selected text is located in a body of the electronic mail message (figs 2s', 6s' and 5).

With respect to claim 12, graham teaches wherein the selected text is located in an attachment attached to the electronic mail message (figs. 2s, document containing image file, and col. 4, lines 45-56).

Claim 23 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 26 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 27 is essentially the same as claim 1 except that it is directed to a computer program product in a computer readable medium rather than a method, and is rejected

8.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent

No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent

No.: US 5,664,207 issued to Crumpler et al. (hereinafter Crumpler) and further in view

of Pub. No.: US 20030206189 A1 of DeMello et al. (hereinafter DeMello).

With respect to claim 8, Graham in view of Crumpler discloses a method for

identifying topics as discussed in claim 1.

Graham and Zimmerman disclose substantially the invention as claimed.

Graham and Crumpler do not teach wherein the data structure is a download file.

However, DeMello teaches download/upload document 9section 0041).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to combine the teachings of Graham in view of

Crumpler with the teachings of DeMello by incorporating the use of downloading the file.

One having ordinary skill in the art would have found it motivated to utilize the use of a

designated set of recipients in response to receiving the user input selecting the text as

disclosed (Crumpler's col. 3, lines 45-62 and col. 4, lines 38-56), into the system of

Graham for the purpose of automatically distributed the information to all the user in the

communication network, thereby, automatic sharing of information is provided more

efficient (Crumpler's col. 4, lines 38-56).

9.   Claims 14, 16-22 and 25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter

Graham) in view of Pub. No.: US 2004/0199529 A1 of Clark et al. (hereinafter Clark).

With respect to claim 14, Graham teaches a method in a data processing system

for sharing text in an electronic book (displaying/selecting stored electronic document

containing a plurality of pages with visual indications of the locations such as

highlighting the text" figs. 2s', 3, 4 and 9's, col. 3, lines 18-67);

receiving a first user input selecting the text from the electronic book through a

communications link to the data processing system (using the mouse as input device for

receiving the text from electronic document or e-book to form a selected text by

highlighted the selected text after the e-book is displayed (fig. 1, item 36 or 30, fig. 2's

item 220 and 224, col. 3, lines 56-67 and col. 4, lines 1-8); responsive to user input and

displaying the text (figs. 2s', 9s').

Graham teaches a method for highlighted or annotated text of stored electronic

document or e-book, which contains plurality of pages including table of contents,

receiving a user input via input device such as mouse or keyboard and highlighting the

selected text after the e-book is displayed. Graham does not clearly teach sorting the

selected text from the at least one remote electronic book using a selection criteria to

form sorted text.

However, Clark teaches automatically organizing or sorting stored electronic

message or document (abstract and sections 0002-0005).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Clark. One having ordinary skill in the art would have found it motivated to utilize the use of organizing the stored electronic document and displaying the text as disclosed (Clark's sections 0002-0005), into the system of Graham for the purpose of automatically organizing the stored electronic document or electronic messages, thereby, searching the stored electronic document more efficient (Clark's section 0011 and 0015).

With respect to claims 16-17, Graham teaches a method in a data processing system for sharing text in an electronic book as discussed in claim 14.

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach wherein selection criteria are used to sort and group the selected text, and wherein the selection criteria includes at least one of popularity, name of a user originating text within the selected text, and subject matter of portions or text within the selected text.

However, Clark teaches a set of search criteria 9sections 0012 and 0223).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Clark. One having ordinary skill in the art would have found it motivated to utilize the use of selecting of search criteria for thee stored electronic document and

displaying the text as disclosed (Clark's sections 0011 and 0223), into the system of

Graham for the purpose of automatically organizing the stored electronic document or

electronic messages, thereby, searching the stored electronic document more efficient

(Clark's section 0011 and 0015).

With respect to claim 18, Graham teaches wherein the selected text includes

passages from at least one remote electronic book (user over the Internet (col. 4, lines

45-67).

With respect to claim 19, Graham teaches wherein the selected text includes

annotations made by a user (section 0209).

With respect to claim 20, Graham teaches wherein the selection criteria are

received from a user input (fig. 1, using the mouse, item 36).

With respect to claim 21, Graham teaches wherein the selection criteria are

received with the selected text (figs. 2A)..

With respect to claim 22, Graham teaches wherein the sorted text excludes a

portion of the selected text (figs. 2s' and 9s').

Claim 25 is essentially the same as claim 14 except that it is directed to a data

processing system rather than a method, and is rejected for the same reason as applied

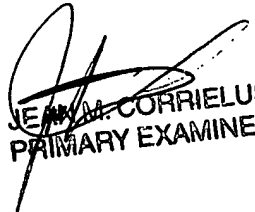to the claim 14 hereinabove.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV **or fax to (571) 273-4039.** The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner Jean Corrielus (571) 272-4032.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov.** Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center (571) 273-8300**

ANH LY
OCT. 14th, 2005

JEAN CORRIELUS
PRIMARY EXAMINER